Inventor(s): UESHIMA et al.

Attorney Docket No.: 100341-00008

REMARKS

The following remarks are fully and completely responsive to the Office

Action dated January 4, 2005.

Claims 1 and 11 have been amended. Applicants submit that the

amendments made herein are fully supported by the disclosure of the application

as originally filed, and therefore no new matter has been added. Accordingly,

claims 1-11 are pending in the present application and are respectfully submitted

for reconsideration.

Claim Objection

Claim 11 has been amended to correct the minor informality highlighted by

the Examiner. Applicants therefore request withdrawal of the objection.

Rejection under 35 U.S.C. § 103(a)

Claims 1, 3-4, 6 and 9 were rejected under 35 U.S.C. §103(a) as being

unpatentable over Lipps et al. (U.S. Patent No. 5,741,182, hereinafter "Lipps") in

view of Lipsons (U.S. Patent No. 5,435,554). Applicants respectfully traverse

the rejection and submit that each of these claims recites subject matter that is

neither disclosed nor suggested by the cited prior art.

Claim 1 recites a sensing ball game apparatus comprising, among other

features, a game processor for receiving the acceleration correlated signal and

causing a change in the ball character being displayed on the screen based on

the acceleration correlated signal.

TECH/241851.1

-6-

Inventor(s): UESHIMA et al.

Attorney Docket No.: 100341-00008

It is respectfully submitted that the prior art fails to disclose or suggest at

least the above-mentioned features of the Applicants' invention.

The Office Action characterized Lipps as allegedly disclosing,

a game processor is utilized for causing a change in

the batter displayed on a screen (column 3, lines 13-

17; Fig. 1). Lipps et al. teaches that the batter's swing

is sensed via a centrifugal switch and the appropriate

signals are transmitted to a game system. When the

bat is swung, the centrifugal force (acceleration

correlated signal) causes a weight to move toward a

switch. At swing speeds faster than some critical

speed (predetermined level), the weight has enough

force to actuate the switch (column 5, lines 58-67; column 6, lines 12-26). See, paragraph 4 of Office

column 6, lines 12-26). See, paragraph 4 Action. (Emphasis added)

In addition, the Office Action noted that "Lipps et al. fails [sic] to explicitly

teach causing a change in the ball character being displayed on the screen," and

relies on Lipson for teaching "that once the result of the hit ball is determined,

flow enters state 404 where the appropriate animation sequence is displayed on

the video screen to include the previously hit ball and the advancement of any

runners on base (column 12, lines 32-42)."

Applicants submit that neither Lipps nor Lipson disclose or suggest each

and every element recited in claim 1 of the present application for at least the

following reasons.

It is submitted that the centrifugal force of Lipps is neither comparable nor

analogous to the presently claimed element of "an acceleration correlated

signal." Lipps merely discloses "a centrifugal switch, consisting of a small steel

weight, a guide to allow the weight to move, and a switch that is activated by the

TECH/241851.1 -7-

force of the moving weight." Lipps further discloses that "when the bat is swung,

the centrifugal force causes the weight to move toward the switch" and "at swing

speeds faster than some critical speed, the weight has enough force to actuate

the switch." See, Lipps, column 6, lines 12-15 and lines 23-26.

Applicants submit that the centrifugal switch of Lipps is merely a

mechanical function, wherein the movement of the weight within the bat triggers

a mechanical switch response. Hence, Lipps fails to generate a calculated

electrical signal. In contrast, the present invention provides an acceleration

signal that is derived from measuring and calculating an acceleration-related

value, which is an electrical function and response. For example, the

acceleration correlated signal of the present invention is a signal having a

magnitude changed in correlation to a magnitude of the acceleration that is

applied to the input device.

Furthermore, it is submitted that the cited prior art fails to teach or suggest

at least the feature of "a game a processor for receiving the acceleration

correlated signal and causing a change in the ball character being displayed on

the screen based on the acceleration correlated signal." Applicants concur with

the Examiner's position that the primary reference of Lipps "fails to explicitly

teach causing a change in the ball character displayed on the screen."

Yet, the secondary reference of Lipson merely discloses the calculation of

ball trajectory (i.e., ball character) and changes in animation sequence displayed

However, Applicants submit that the change in ball on the video screen.

character displayed on the screen, as disclosed by Lipson, is neither equivalent

TECH/241851.1 -8-

Inventor(s): UESHIMA et al.

Attorney Docket No.: 100341-00008

nor comparable to the change in ball character of the presently claimed

invention. Specifically, Lipson merely teaches "pitch quality" and "swing timing"

as the factors calculated to determine ball character. Moreover, Lipson provides

that the "ball trajectory is determined by the initial hit angle and the initial velocity

of the ball coming off the bat." However, there is no teaching or suggestion that

Lipson considers acceleration as a factor when calculating the movement of the

input device.

Therefore, Applicants submit that Lipps in view of Lipson fail to disclose

each and every element recited in claim 1 of the present application.

To establish prima facie obviousness, each feature of a rejected claim

must be taught or suggested by the applied art of record. See M.P.E.P.

§2143.03 and In re Royka, 490 F.2d 981 (CCPA 1974). As explained above,

Lipps and Lipson, taken alone or in combination, do not teach or suggest each

feature recited by pending Claim 1. Accordingly, for the above provided reasons,

Applicants respectfully submit that pending Claim 1 is not rendered obvious

under 35 U.S.C. § 103 by the teachings of Lipps and Lipson, and therefore is

allowable.

As claims 2-4, 6 and 9 depend from claim 1, Applicants submit that each

of these claims incorporates the patentable aspects therein, and are therefore

allowable for at least the reasons set forth above with respect to the independent

claims, as well as for the additional subject matter recited therein.

References Not Combinable

Moreover, Applicants submit that the cited references are not combinable

-9-

TECH/241851.1

Inventor(s): UESHIMA et al.

Attorney Docket No.: 100341-00008

because each of the references disclose significantly different operations and game play. For example, the joystick input device as provide by Lipson fails to operate in the same manner as the output disclosed in Lipps, and therefore are not combinable to function according to the present invention. It is submitted that one skilled in the art would concluded that the structural configuration of a joystick as an input device is significantly incompatible with a swingable input device such as in Lipps. Specifically, the structural components of the joystick fail to provide an output, nor be able to provide an output of a signal based on the velocity of the movement. Consequently, the processors in Lipson would be different from (in structure and in function) and not combinable with, the

processor in Lipps. Thus, Applicants submit that the cited prior art are not

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. <u>In re Fine</u>, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. <u>Id</u>. In order to establish obviousness, there must be a suggestion or motivation in the reference

combinable.

to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior

art could not be turned upside down without motivation to do so); In re Rouffet,

149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999);

In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the

advantages of the present invention to justify the combination of references.

There is, however, nothing in the applied references to evidence the desirability

of these advantages in the disclosed structure.

Applicants respectfully request withdrawal of the rejection.

Claims 5, 7, 8, 10 and 11 Rejected Under 35 U.S.C. § 103(a)

Claims 5 and 8 were rejected under 35 U.S.C. §103(a) as being

unpatentable over Lipps and Lipson in view of Tosaki et al. (US Patent No.

6,517,438, hereinafter "Tosaki").

Claim 10 was also rejected under 35 U.S.C. § 103(a) as being

unpatentable over Lipps and Lipson in view of Zur et al. (US Patent No.

6,517,438, hereinafter "Zur").

Furthermore, claims 7 and 11 were rejected under 35 U.S.C. §103(a) as

being unpatentable over Lipps and Lipson in view of Marinelli (US Patent No.

6,157,898).

Applicants respectfully traverse the rejection and submit that each of these

claims recites subject matter that is neither disclosed nor suggested by the cited

prior art.

Applicants submit that neither Tosaki, Zur nor Marinelli make up for the

deficiencies of Lipps in view of Lipson discussed above. And as claims 5, 7, 8,

-11-

TECH/241851.1

Inventor(s): UESHIMA et al.

Attorney Docket No.: 100341-00008

10 and 11 depend from claim 1, Applicants submit that each of these claims

incorporates the patentable aspects therein, and are therefore allowable for at

least the reasons set forth above with respect to the independent claims, as well

as for the additional subject matter recited therein.

Conclusion

In view of the foregoing, reconsideration of the application, withdrawal of

the outstanding rejections, allowance of claims 1-11 and the prompt issuance of

a Notice of Allowability are respectfully solicited.

Should the Examiner believe anything further is desirable in order to place

this application in better condition for allowance, the Examiner is requested to

contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, Applicants

respectfully petition for an appropriate extension of time. Any fees for such an

extension, together with any additional fees that may be due with respect to this

paper, may be charged to counsel's Deposit Account No. 01-2300, referencing

docket number 100341-00008.

Respectfully submitted.

Plan

ARENT FOX/PI

&am Huang

Registration No.: 48,430

Customer No.: **004372**

1050 Connecticut Avenue, N.W. Washington, D.C. 20036-5339

Telephone No.: 202-857-6000

Facsimile No.: 202-638-4810

SH/mvb